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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,927	12/09/2003	Darrel Robert Slowski	DWE/SLOWSKI	2425

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EXAMINER

HOGE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,927	Applicant(s) SLOWSKI, DARREL ROBERT	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finnerty (3,680,237) in view of Arnold (3,680,238), Johnson (3,404,474), Matthews (4,272,901) and Weiss et al. (6,367,180).

Finnerty discloses a luminescent display for use in illuminating identification indicia, including a weatherproof housing (col. 1, lines 17-23) for attachment to a support surface; and a phosphorescent screen 25 within the housing (Fig. 2). It is not known how large the screen is. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the screen in excess of twenty square inches because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, Finnerty does not disclose a UV protective layer over the screen. Arnold teaches that it was known in the art to provide a display of the type disclosed by Finnerty with a front layer that absorbs UV light. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the display disclosed by Finnerty with a layer in front of the screen that absorbs UV light, as taught by Arnold, in order to protect the interior of the display from the damaging effects of exposure to UV light. Further, Finnerty

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discloses internally-mounted, stencil type indicia, rather than externally-mounted silhouette type indicia. Johnson teaches that it is a known equivalent arrangement to use externally-mounted silhouette type indicia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use externally-mounted silhouette type indicia in the device disclosed by Finnerty, as taught by Johnson, as an obvious matter of choice in design. Further, Finnerty does not disclose operating the screen at a voltage that is less than the rated voltage of the screen. Matthews teaches that it was known in the art to operate an illuminated display at less than its rated voltage, in order to “provide an expected life much greater than the normal life expectancy” (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the screen disclosed by Finnerty at less than its rated voltage, as taught by Matthews, in order to achieve a life expectancy that is much greater than the normal life expectancy. Further, Finnerty does not disclose a light sensor that disconnects the energizing means when the ambient light exceeds a predetermined threshold level. Weiss teaches that it was known in the art to use a light sensor to deactivate an illuminated display at dawn (col. 4, lines 23-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide that device disclosed by Finnerty with a light sensor that turns the device off when the ambient light exceeds a predetermined threshold level, as taught by Weiss, in order to extend the life of the screen by not using it during daylight hours.

3. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (3,404,474) in view of Matthews (4,272,901) and Weiss et al. (6,367,180).

Johnson discloses a house number identification panel having a plurality of number indicia in selected arrangement positioned externally upon a viewing screen (see Fig. 5). It is not

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known from how far away the indicia are legible. However, that is a function of the size of the indicia, and it would have been obvious to one having ordinary skill in the art to make the indicia a suitable size to be legible from any desired distance, because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Johnson further discloses a phosphorescent screen **34** and electrical supply means. However, Johnson does not disclose operating the screen at a voltage that is less than the rated voltage of the screen. Matthews teaches that it was known in the art to operate an illuminated display at less than its rated voltage, in order to “provide an expected life much greater than the normal life expectancy” (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the screen disclosed by Johnson at less than its rated voltage, as taught by Matthews, in order to achieve a life expectancy that is much greater than the normal life expectancy. Further, Johnson does not disclose a light sensor that disconnects the energizing means when the ambient light exceeds a predetermined threshold level. Weiss teaches that it was known in the art to use a light sensor to deactivate an illuminated display at dawn (col. 4, lines 23-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide that device disclosed by Johnson with a light sensor that turns the device off when the ambient light exceeds a predetermined threshold level, as taught by Weiss, in order to extend the life of the screen by not using it during daylight hours.

Regarding claim 8, it is not known how tall the indicia disclosed by Johnson are. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make them up to about four inches tall, because it has been held that

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discovering an optimum value of a result effective variable involves only routine skill in the art.

In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

4. Claims 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finnerty (3,680,237) in view of Johnson (3,404,474) and Matthews (4,272,901).

Finnerty discloses a luminescent display for use in illuminating identification indicia, including a vapour-proof housing (col. 1, lines 17-23) for attachment to a support surface; and a phosphorescent screen 25. However, Finnerty discloses internally-mounted, stencil type indicia, rather than externally-mounted silhouette type indicia. Johnson teaches that it is a known equivalent arrangement to use externally-mounted silhouette type indicia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use externally-mounted silhouette type indicia in the device disclosed by Finnerty, as taught by Johnson, as an obvious matter of choice in design. Further, Finnerty does not disclose operating the screen at a voltage that is less than the rated voltage of the screen. Matthews teaches that it was known in the art to operate an illuminated display at less than its rated voltage, in order to "provide an expected life much greater than the normal life expectancy" (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the screen disclosed by Finnerty at less than its rated voltage, as taught by Matthews, in order to achieve a life expectancy that is much greater than the normal life expectancy.

Regarding claim 14, It is not known how large the screen is. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the screen in excess of twenty square inches because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within

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the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, it is not known how tall the indicia disclosed by Finnerty are. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make them up to about four inches tall, because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finnerty (3,680,237) in view of Johnson (3,404,474) and Matthews (4,272,901), as applied to claim 11, above, and further in view of Weiss et al. (6,367,180).

Finnerty discloses the invention substantially as claimed, as set forth above. However, Finnerty does not disclose a light sensor that disconnects the energizing means when the ambient light exceeds a predetermined threshold level. Weiss teaches that it was known in the art to use a light sensor to deactivate an illuminated display at dawn (col. 4, lines 23-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide that device disclosed by Finnerty with a light sensor that turns the device off when the ambient light exceeds a predetermined threshold level, as taught by Weiss, in order to extend the life of the screen by not using it during daylight hours.

Response to Amendment

6. The declaration under 37 CFR 1.132 filed May 17, 2006 is insufficient to overcome the rejection of claims 1, and 5-14 based upon Finnerty (3,680,237), Arnold (3,680,238), Johnson (3,404,474), Matthews (4,272,901) and Weiss et al. (6,367,180) as set forth in the last Office action.

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First, the declaration is merely the opinion of the Applicant, who is not a disinterested party. As such, it carries little weight. Further, paragraphs 1-10 merely state advantages of the instant invention and do not explain how the claims are patentable over the cited references.

Paragraph 11 comments on drawbacks present in the prior art, or on features which were not relied upon in the rejection (while ignoring those that were), but does not address the combination as set forth by the Examiner.

Regarding the operation of the light source at reduced voltage, Matthews teaches this concept in order to prolong the life of the light source. A person having ordinary skill in the art would be able to apply this principle to an electroluminescent light source. Further, claims 1 and 11 recite that the energizing means is "for applying a predetermined voltage . . . said predetermined voltage being less than the rated voltage of said screen." Thus, the recitation regarding the reduced voltage is the object of a statement of intended use, and does not define over the art anyway, because it only requires that the prior art be *capable* of delivering a voltage that is less than the rated voltage, which it is. Claim 7 is worded differently, but also appears to be a statement of intended use.

Similarly, it being obvious to change the size of a thing, a person having ordinary skill in the art would know how to provide sufficient power to a larger electroluminescent light, especially if, in light of the teachings of Matthews, that light were going to be operated at reduced voltage anyway.

Applicant states that "Weiss's use of a timer is for the purpose of switching on his battery-driven circuit, and is intended solely to prolong his battery life. There is no mention of any effect upon lamp life!" (emphasis in original). But in the above rejection, the Examiner

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referred to column 4, lines 23-26, of Weiss, which states that if the address display were illuminated using household AC power, "[t]he time[r] would also be unnecessary, and the illuminateable panel could be illuminated from dusk till dawn by means of the photoresistor dusk sensor." The reason for shutting the display off during the day is to save energy and to prolong the life of the lamp, as is well known in the art.

Response to Arguments

7. Applicant's arguments filed May 17, 2006 have been fully considered but they are not persuasive for the reasons set forth above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C Hoge
Primary Examiner
Art Unit 3611

gch